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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/602,892	06/23/00	GABAI	8

QM32/0508

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EXAMINER	
CHENG, J	
ART UNIT	**PAPER NUMBER**
3713	5

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/602,892	GABAI ET AL.	
	Examiner	Art Unit	
	Joe H. Cheng	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21 and 25-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21 and 25-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/081,255* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

1. In response to the Preliminary Amendment filed on June 23, 2000, claims 22-24 and 49-57 have been cancelled, and claims 1-21 and 25-48 are pending.

Specification

2. The disclosure is objected to because of the following informalities:

The term "This is a division, of application Serial No. 09/081,255, filed May 19, 1998. Each of these prior applications is hereby incorporated herein by reference, in its entirety." On Pg. 1, line 1, should be recited as --This is a division of application Serial No. 09/081,255, filed May 19, 1998, now U.S. Patent No. 6,160,986, which is hereby incorporated herein by reference in its entirety.--, so as to clarify the status. Further, the term "Fig. 24 is a drawing showing a creature equipped with a build-in video camera and video display;" on Pg. 18, line 25, should be recited as --Fig. 24C is a drawing showing a creature equipped with a build-in video camera and video display;--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-21 and 25-39 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to claim 1, the term "one user:" (line 6) should be recited as --one user; and--, so as to clarify the confusion.

Regarding to claims 17 and 18, the antecedent basis for "said content storage unit" has not been clearly set forth.

Regarding to claim 25-30, the recitation therein is unclear and confusing. The structural connections and cooperative relationships among the "speech recognition unit" and the "audio storage unit" have not been set forth. In other words, the recitations in these claims are merely directed to an aggregation of parts without clearly setting forth their function as well as their interconnections and interrelationship as required. Further, it is noted that without the structural element of the "controller", the claimed toy apparatus can not perform the claimed interactive verbal game. Moreover, the antecedent basis for "at least one of the verbal strings" (as per claims 29 and 30) is lacking.

Regarding to claim 33, the term "n audio memory" should be recited as --an audio memory -- to clarify the confusion.

Regarding to claim 34, it is not understood as to whether the "microphone" is referred to "user input receiver" (as per claim 1) or not.

Claims 2-16, 19-21, 31, 32, 35-39 are rejected for incorporating the above errors from their respective parent claims by dependency.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Curran (U.S. Pat. No. 4,923,428).

Regarding to claims 25 and 28-30, Figs. 1-21 of Curran broadly discloses the toy apparatus for playing the interactive verbal game comprising the toy (11) having a fanciful physical appearance, the speaker (33), the microphone (31) and the speech recognition unit ((91, 93, 95, 103) for providing speech input, the storage unit (35, 103) for storing a multiplicity of verbal game segments to be played to a user via the speaker and the script storage defining branching between alternative sections of the verbal game segments (see Figs. 15 and 18-21), and wherein at least one verbal game segment is the riddle, or is the verbal strings having educational content, or having feedback to the user regarding the quality of the user's performance in the game.

Claim Rejections - 35 USC § 103

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-3, 5-21, 26, 27 and 34-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curran (U.S. Pat. No. 4,923,428).

Regarding to claims 1-3, 5-21, 26, 27 and 34-45, Figs. 1-21 of Curran broadly discloses the interactive toy apparatus and method comprising the toy (11) having a fanciful physical appearance, the speaker (33), the microphone (31) and the speech recognition unit ((91, 93, 95, 103) for providing verbal input, the user information storage unit (35, 103) having the content storage unit storing a plurality of audio file which is the multiplicity of verbal game segments to be played to a user via the speaker and the script storage defining branching between alternative sections of the verbal game segments (see Figs. 15 and 18-21), and the content controller (103) operative in response to current user inputs and to information stored in the storage unit for providing audio content regarding to the user's participation performance to the user via speaker. It is noted that the teaching of Curran does not specifically disclose the information stored in the user information storage unit is related to the personal information (as per claims 5 and 41) of at least one user (as per claims 1 and 40), or is related to the interaction of the at least one user (as

per claims 6, 7 and 42), or information input verbally by the user via the user input receiver (as per claims 8-10), or is related to the identifiable unique code for each user (as per claims 20 and 44), or is related to the user's participation performance (as per claims 21 and 45), and the content controller is operative to prompt any user to provide the user's code (as per claims 20 and 44), or to prompt the user to generate a spoken input into the verbal game (as per claims 26 and 35) or strings (as per claims 27 and 36) as required. However, such limitations of the information stored in the user information storage unit is related to the personal information of at least one user, or is related to the interaction of the at least one user, or information input verbally by the user via the user input receiver, or is related to the identifiable unique code for each user, or is related to the user's participation performance, and the content controller is operative to prompt any user to provide the user's code, or to prompt the user to generate a spoken input into the verbal game or strings are old and well known, and are considered an arbitrary obvious design choice, so as to store different type of information for interactive between the user and the toy and to invite the user to interactive with the toy.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curran (U.S. Pat. No. 4,923,428) in view of Collins et al (U.S. Pat. No. 5,855,483) .

Regarding to claim 4, it is noted that the teaching of Curran does not specifically disclose the tactile input receiver as required. However, the teaching of Collins et al broadly discloses that such feature of the user input receiver (12, 200) is a tactile input receiver (see Figs. 4, 6-8 and 10-26) is old and well known, and is considered an arbitrary obvious design choice. Hence, it would have been obvious to one of ordinary skill in the art to modify the system of Curran

with the feature of the tactile input receiver as taught by Collins et al as both Curran and Collins et al are directed to the interactive toy apparatus, so as to provide the tactile input to the interactive toy.

11. Claims 31-33 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curran (U.S. Pat. No. 4,923,428) in view of Cimerman et al (U.S. Pat. No. 5,700,178).

Regarding to claims 31-33 and 46-48, it is noted that the teaching of Curran does not explicitly disclose the multi-featured face apparatus and the facial expression control unit (as per claims 31 and 46) to generate the illusion of different emotions (as per claims 32 and 47), or to generate the combinations of the facial expression synchronously with the output of the audio pronouncement (as per claims 33 and 48) as required. However, the teaching of Cimerman et al broadly discloses that such features of the toy (10) having the multi-featured face apparatus (500) and the facial expression control unit (620) to generate the illusion of different emotions which is synchronously with the output of the audio pronouncement is old and well known. Hence, it would have been obvious to one of ordinary skill in the art to combine the system of Curran with the feature of the multi-featured face apparatus and the facial expression control unit to generate the illusion of different emotions, or to generate the combinations of the facial expression synchronously with the output of the audio pronouncement as taught by Cimerman et al as both Curran and Cimerman et al are directed to the interactive toy apparatus, so as to provide the interactive toy having the animated display with the emotion expression relating to the audio output.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703)308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Joe H. Cheng
Primary Examiner
Art Unit 3713

Joe H. Cheng
May 4, 2001